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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,659	02/25/2004	Karen O'Leary	63193.00001	2842

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EXAMINER

TRAN, HANH VAN

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/786,659	O'LEARY	
	Examiner	Art Unit	
	Hanh V. Tran	3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-19,22-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-19,22-28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the Final Office Action from the examiner in charge of this application in response to applicant's amendment dated 4/7/2006.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5, 8-19, 22-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 15, the limitation an indicator having a plurality of configurations is vague, thus indefinite for failing to clearly define how it is possible for just one indicator to have a plurality of configurations. Claim 30, there is an inconsistency between the language in the preamble and certain portion in the body of the claim, thereby making the scope of the claim unclear. The preamble clearly indicates a subcombination of an apparatus is being claimed, i.e., "An apparatus for providing privacy for an individual at a workspace, comprising". However, in at least one instance in the body of the claim, the combination of an apparatus and the workspace are being claimed, i.e., "a bottom portion of the panels rests on the top surface of the workspace". The examiner cannot be sure whether applicant's intent is to claim the subcombination off an apparatus or the combination of an apparatus and a workspace. Applicant is required in response to this office action to clearly state applicant's intent, and to amend the claim accordingly.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-4, 8-12, 14, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 3,629,960 to Roush.

Roush discloses an apparatus for providing privacy for an individual at a workspace, comprising, such as shown in Fig 1, a front panel 10; a first side panel 12 coupled to a first portion of the front panel; and a second side panel 14 coupled to a second portion of the front panel, the panels having a first configuration wherein the panels may stand or rests on a surface of the workspace to provide the privacy and a second configuration wherein the panels may be folded along the first portion of the front panel and the second portion of the front panel, the second configuration comprises a stack of the panels, one or more laminas over one or more of the panels, an indicator coupled to one or more of the panels, the indicator having a plurality of configurations, one configuration of the indicator indicates that the individual is working on an assignment and another configuration of the indicator indicates that the individual has completed the assignment, the indicator comprises a rotatable member, means for retaining a writing instrument, the retaining means being coupled to one or more of the panels, means for displaying marking, the displaying means being coupled to one or more of the panels, the marking comprises one or more of a name and goals for the

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individual, the panels have a thematic silhouette in at least the first configuration, means for retaining an award earned by the individual, the retaining means being coupled to one or more of the panels.

6. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 3,538,976 to Gilbert.

Gilbert discloses an apparatus for providing privacy for an individual at a workspace, comprising, such as shown in Fig 1, a front panel 10; a first side panel 12 coupled to a first portion of the front panel; and a second side panel 14 coupled to a second portion of the front panel, the panels having a first configuration wherein the panels may stand on a surface of the workspace to provide the privacy and a second configuration wherein the panels may be folded along the first portion of the front panel and the second portion of the front panel, wherein the first configuration comprises a concave arrangement of the panels wherein each panel has a bottom portion resting on the surface of the workspace, the second configuration comprises a stack of the panels, one or more laminas over one or more of the panels.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 13, 15, 17-18, and 22-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roush.

Roush discloses all the elements as discussed above except for the thematic silhouette comprises a castle-like silhouette, and the method steps recited in said claims.

However, since Roush already teaches the idea of providing thematic silhouette to the apparatus, it would have been obvious and well within the level of one skill in the art to modify the structure of Roush by having the thematic silhouette comprising a castle-like silhouette. Further, it would have been an obvious matter of design choice for aesthetic purpose to use various thematic silhouettes. In regard to the method claims, since Roush, as modified, discloses all the elements recited in said claims, it would have been well within the level of one skill in the art to perform the method steps recited therein.

10. Claims 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert.

Gilbert discloses all the elements as discussed above except for the method steps recited in said claims. However, since Gilbert discloses all the elements recited in said claims, it would have been well within the level of one skill in the art to perform the method steps recited therein.

Response to Arguments

11. Applicant's arguments filed 4/7/2006 have been fully considered but they are not persuasive. In response to applicant's arguments on page 6 that Roush fails to disclose the indicator having a plurality of configurations, the examiner takes the position that the claim language fails to provide adequate structural limitations to the claim by clearly define the indicator and the configurations of the indicator in order to distinguish from the prior art of record; and Roush meets the claimed limitation of the indicator having a plurality of configurations, e.g., any one of the attachments such as elements 70-74 can be used as an indicator.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (571) 272-6868. The examiner can normally be reached on Monday-Thursday, and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HVT *HVT*
June 23, 2006

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SUPERVISORY PATENT EXAMINER
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